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10/024,800	12/19/2001	Paul F. Nugent JR.	10183	6090
26884	7590	03/06/2006	EXAMINER	
PAUL W. MARTIN NCR CORPORATION, LAW DEPT. 1700 S. PATTERSON BLVD. DAYTON, OH 45479-0001			GIBSON, RANDY W	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/024,800
Filing Date: December 19, 2001
Appellant(s): NUGENT, PAUL F.

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GROUP 2800

Paul J. Maginot
For Appellant

SUBSTITUTE EXAMINER'S ANSWER

This is in response to the appeal brief filed 7 February 2006 appealing from the Office action mailed 23 June 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

United States patent application publication No.: US 2003/0111275 A1 (*Sternberg*)¹
published 19 June 2003 (filed 18 December 2001).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 2, 5, 8-11, and 15-19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by *Sternberg*. *Sternberg* discloses the claimed invention including an electronics box (50) and two elongated support members (20) with strain gages (p. 3, paragraph 0038) where the sole structural connection between the two support members is a surface plate (12). The fact that the support plate (12) is connected to

1. The examiner notes that the serial number of *Sternberg* given in the final rejection, and also found on the PTO-892, is incorrect. The serial number given in the Examiner's Answer is correct.

the support members (20) via extension members (14) is not deemed significant since the claims as worded do not exclude such an embodiment.

2. Claims 3, 4, 6, 7, 12-14 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sternberg*. *Sternberg* discloses the claimed invention, as discussed *supra*, except for the limitations of the exact location of the electronics box, the limitation of making the plate more rigid as the separation of the two members is increased, the exact type of cable used, the exact dimensions of the support members, and the plate being transparent to a barcode scanner.

It does not appear that the precise location of the electronics box is critical to the operation of the device; the courts have held that merely shifting the position of a part in a way which does not change the operation of the device is a design choice which would have been obvious to the ordinary practioner. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975): and, *MPEP* § 2144.04 (VI)(C).

It is inherent that the bed frame would have to be made more rigid to prevent it from collapsing if it were made larger. The examiner takes official notice that beds come in different sizes such as single, twin, full, queen, king, etc. The examiner notes that the courts have held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device, and a device having the claimed relative dimensions would not perform differently than the prior art device, then the claimed device was not patentably distinct from the prior art device;

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Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984); see also *MPEP* §§ 2144.02, 2144.03, & 2144.04 (IV)(A).

The R5232 lead is an off the shelf component which the applicant admits that he did not invent; it would have been obvious to the ordinary practitioner to use a known part for its intended purpose. See *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); and, *MPEP* §§ 2129 & 2144.07.

As for the exact length of the support members, the Federal Circuit has held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, then the claimed device is not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

As for the plate being transparent to radiation from a bar code scanner, the examiner notes that the supporting frame of a bed is usually not a continuous solid surface but rather comes as a wire grid for supporting a mattress; such a grid would inherently allow light to pass through its many apertures.

(10) Response to Argument

The only issue that the appellant is arguing on appeal is the meaning of the word “plate”, and whether the word “plate” can reasonably be interpreted broadly enough to cover a mattress and/or bed frame. The appellant points out in a footnote that one definition of “plate” found in a dictionary defines the word “plate” as “a flat, thin piece of material, such as metal”. The appellant also points out that one patent cited by the examiner also describes a flat element as a “plate” in its specification. In response, the examiner notes that the term “plate” has so many definitions in the dictionary; the examiner fails to see how the appellant can limit the term “plate” as narrowly as he argues unless he amends the written description to include an express definition of the word.

For example, the examiner notes that Webster’s defines “plate” (definition number 5) as “a horizontal structural member that provides bearing and anchorage”.² The bed frame of Sternberg is a “horizontal” feature that serves as a structural member for the bed, at least. Dictionary dot com defines “plate” (definition #1) as “[a] smooth, flat, relatively thin, rigid body of uniform thickness.”³ The bed of Sternberg certainly is “smooth”, “flat” and has “uniform thickness”. The bed frame is obviously “rigid” also (The term “relatively thin” in this particular definition doesn’t seem to be limiting since it is not clear if the bed is “thin” relative to something, when that something is undefined.

2. *Webster’s Ninth New College Dictionary*, Merriam-Webster Inc., Springfield, MA, USA, ©1990. p. 901.

3. Dictionary.com at < <http://dictionary.reference.com/> >, Copyright © 2005, Lexico Publishing Group, LLC.

I.E.: thin “relative” to what?). Since the term “plate” is not expressly defined in the specification, the examiner fails to see why a judge or jury in a future infringement case would be bound to a narrow definition of “plate” when the very same dictionary also has very broad definitions of “plate” also. It appears that the appellant is trying to impermissibly read limitations from the specification into the claim. *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If the appellant intended to limit himself to a narrow definition of the word “plate”, then he needed to amend either the written description or the claims to expressly include this narrower definition in order to give future parties adequate notice that the appellant intends to be bound to a narrow interpretation of that term. See **MPEP** § 2111.01:

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. > *In re American Academy of Science Tech Center*, ___ F.3d ___, 2004 WL 1067528 (Fed. Cir. May 13, 2004)(The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation.)< This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ... *Chef America, Inc.*

v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)...

... One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. >See, e.g., *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)(discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment).< It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). >See also *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004) ("Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment."); *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to

interpret claims in view of the specification' without unnecessarily importing limitations from the specification into the claims."); *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003)...

... **If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms.** *Brookhill-Wilk 1*, 334 F. 3d at 1300, 67 USPQ2d at 1137; see also *Renishaw PLC v. Marposs Societa ' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings."). If more than one extrinsic definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all consistent meanings. *Tex. Digital*, 308 F.3d at 1203, 64 USPQ2d at 1819. See also *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001)(explaining the court's analytical process for determining the meaning of disputed claim terms); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.") [emphases added].

Appellant's attempt to give the term "plate" a special definition in his Appeal Brief is not sufficient for the Patent & Trademark Office to interpret the term more narrowly than the dictionary does, absent an express definition in either the claims or the written description, which the appellant has so far failed to provide.

Furthermore, appellant's footnote remark about the disclosure of U.S. Patent No. 4,043,413 seems to be irrelevant since: (a) appellant never tried to incorporate this patent by reference into his specification; and, (b) this patent does not seem to give an express written definition of the term "plate" either in spite of the fact that a preferred embodiment shows what appears to be a flat, apparently metallic element, and calls it a plate. "One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. >See, e.g., *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)." **MPEP** § 2111.01.

Appellant states that the combination of the mattress 10 and its support frame 12 "does not possess the qualities of a 'plate'", and therefor the bed cannot be considered a "plate". However, the examiner does not believe that the appellant ever clearly or expressly stated in either the written description or the claims what features, or "qualities", that an object had to have in order to be considered a "plate", so this argument is unpersuasive. The appellant never expressly gave the term "plate" any clear metes and bounds in either the written description or the claims. Appellant further seems to imply that the bed cannot be considered a "plate" because it has legs. The examiner notes that a plate with protrusions is still a plate, so this argument is

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unpersuasive. There is nothing in the claims that specify that the plate cannot have legs.

Appellant further argues with respect to claim 16 that the mattress support is not “resting on” either of the scales 20 as claimed because the bed frame has legs interposed between the bed frame and the scales 20, causing the bed frame to be spaced apart from the supports (scales). However, the examiner notes that the bed frame is still “resting upon” the supports 20 even if there are legs imposed in-between because there is no language in the claims requiring that the “plate” rest directly upon its supports. Since the legs of the bed frame are “resting upon” the supports 20, and the bed frame is resting on its legs, then the bed can be fairly said to be “resting upon” scales (supports) 20.

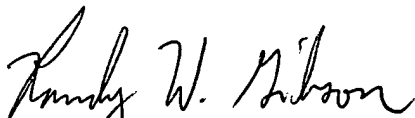
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

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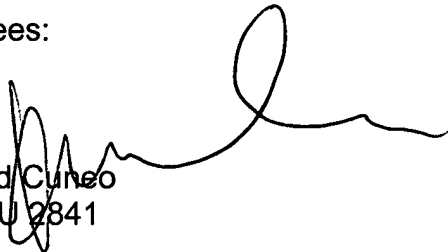
Respectfully submitted,



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May 13, 2005

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